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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,516	09/15/2003	Shenshen Wu	20020002.0350	7840

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EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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07/02/2007 PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/661,516	WU ET AL.	
	Examiner	Art Unit	
	Alvin A. Hunter	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 April 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,5,7,9,17,29,30,48-58 and 60-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 2, 5, 7, 9, 17, 29, 30, 48-58, and 60-64 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 5, 7, 9, 17, 29, 30, 48-58, and 60-64 are rejected under 35 U.S.C. 101.

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include “laws of nature,” “natural phenomena,” and “abstract ideas.” See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a “useful, concrete and tangible result.” See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). This addresses the second test under 35 U.S.C. 101 of whether or not an invention is eligible for a patent. The Manual of Patent Examining Procedure reiterates this point. More specifically, MPEP 2106(II)(A) states, “The claimed invention as a whole must accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result.’ *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02.” Applicant is merely claiming how to make a RIM material, not making a golf ball or a portion of a golf ball. The claim does not recite any language in any of the claims that would lead one skilled in the art to make a golf ball or portion thereof out of the claimed methods.

In conclusion, the Examiner submits that Appellant's claims do not meet the requirement under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 17, 30, 55-57, and 63 are rejected under 35 U.S.C. 102(e) as obvious over Cuscurida et al. (USPN 4301110).

In regards to claim 1 and 63, Cuscurida et al. discloses a process for making a RIM elastomer comprises (a) providing a first reactable component comprising an isocyanate-containing compound and a second reactable component comprising at least one of a polyol, polyamine, or epoxy-containing; (b) combining the reactable components together to form a reactive mixture compound; wherein the reactive mixture has a gelation time and wherein the first and second reactable components naturally has a viscosity of from about 25 to about 5000 cps at ambient temperature or at a temperature at which the reactable components are combined being that Cuscurida et al. discloses the polyol and polyisocyanates of the group disclosed by the applicant, and injecting the reactive mixture into a mold having a desired shape within a first time and wherein the first time is about 10 seconds or less (See Entire document, especially Examples). Though Cuscurida et al. does not explicitly disclose the first time being less

than the gelation time, it is believed to be present because the gelation is dependent of the size of the mold and how quickly the mixture can be injected into the mold before gelation (See Examples). Further it should be noted that the preamble will not be given patentable weight (See MPEP 2111.02). One having ordinary skill in the art would have found it obvious to inject the mixture at any rate into the mold in order to obtain the desired shape before gelation. Applicant has not noted any criticality as to why the process would be any different using an aliphatic isocyanate-containing compound versus an aromatic isocyanate-containing compound. Regarding of the type of isocyanate-containing compound, the components would still go through the same process in order to make the polyurethane. One having ordinary skill in the art would have found the type of isocyanate-containing compound to be an obvious matter of design choice being that Cuscurida et al. still teaches the step of the producing the polyurethane.

In regards to claim 17, Cuscurida already discloses the composition solidifying in about 7.5 second. Being that Cuscurida et al. discloses the same components as that of the applicant it is submitted that the composition is capable of solidifying in less than 5 second.

In regards to claims 30 and 55, Cuscurida et al. discloses a method for forming golf equipment, or a portion thereof in which comprises (a) providing a first reactable component comprising an isocyanate-containing compound and a second reactable component comprising at least one of a polyol, polyamine, or epoxy-containing', (b) combining the reactable components together to form a reactive mixture compound;

wherein the reactive mixture has a gelation time and wherein the first and second reactable components naturally has a viscosity of from about 25 to about 5000 cps at ambient temperature or at a temperature at which the reactable components are combined being that Sullivan et al. discloses the polyol and polyisocyanates of the group disclosed by the applicant, and injecting the reactive mixture into a mold having a desired shape within a first time and wherein the first time is about 10 seconds or less (See Entire document, especially the Examples). Though Cuscurida et al. does not explicitly disclose the first time being less than the gelation time, it is believed to be present because the gelation is dependent of the size of the mold and how quickly the mixture can be injected into the mold before gelation. Further, it should be noted that the preamble will not be given patentable weight (See MPEP 2111.02). One having ordinary skill in the art would have found it obvious to inject the mixture at any rate into the mold in order to obtain the desired shaped before gelation. Cuscurida et al. does not explicitly disclose the amount of hard segment and soft segment to the total weight of the polymer, but one having ordinary skill in the art would have sought each the hard segment (isocyanate containing component) and the soft segment polyol) to be of any percentage of the total weight of the polymer and would have been obvious. Applicant does not set forth the importance or criticality of the amounts of each component; thus it is seen that any amounts can be used to carry out the above method. Applicant has not noted any criticality as to why the process would be any different using an aliphatic isocyanate-containing compound versus an aromatic isocyanate-containing compound. Regarding of the type of isocyanate-containing compound, the components would still go

the through the same process in order to make the polyurethane. One having ordinary skill in the art would have found the type of isocyanate-containing compound to be an obvious matter of design choice being that Cuscurida et al. still teaches the step of the producing the polyurethane.

In regards to claims 56 and 57, see the above regarding claim 30.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cuscurida et al. (USPN 4301110) in view of Bock et al. (USPN 4288586).

In regards to claim 54, Cuscurida et al. does not disclose the first reactable component comprising greater than about 14% by weight isocyanate groups. Bock et al. discloses a first reactable component, in particular a polyisocyanate, having greater than 14% by weight isocyanate groups (See Column 6, lines 5 through 14). One having ordinary skill in the art would have found it obvious to have greater than 14% by weight of isocyanate groups, as taught by Bock et al., in order to more easily process polyurethane.

Claims 29, 48-53, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuscurida et al. (USPN 4301110) in view of Peter (USPN 6174984).

In regards to claims 29 and 58, Cuscurida et al. discloses a method for forming golf equipment, or a portion thereof in which comprises (a) providing a first reactable component comprising an isocyanate-containing compound and a second reactable component comprising at least one of a polyol, polyamine, or epoxy-containing; (b) combining the reactable components together to form a reactive mixture compound; wherein the reactive mixture has a gelation time and wherein the first and second

reactable components naturally has a viscosity of from about 25 to about 5000 cps at ambient temperature or at a temperature at which the reactable components are combined being that Cuscurida et al. discloses the polyol and polyisocyanates of the group disclosed by the applicant, and injecting the reactive mixture into a mold having a desired shape within a first time and wherein the first time is about 10 seconds or less (See Entire document, especially the examples). Though Cuscurida et al. does not explicitly disclose the first time being less than the gelation time, it is believed to be present because the gelation is dependent of the size of the mold and how quickly the mixture can be injected into the mold before gelation. One having ordinary skill in the art would have found it obvious to inject the mixture at any rate into the mold in order to obtain the desired shaped before gelation. Further it should be noted that the preamble will not be given patentable weight (See MPEP 2111.02). Applicant has not noted any criticality as to why the process would be any different using an aliphatic isocyanate-containing compound versus an aromatic isocyanate-containing compound. Regarding of the type of isocyanate-containing compound, the components would still go the through the same process in order to make the polyurethane. One having ordinary skill in the art would have found the type of isocyanate-containing compound to be an obvious matter of design choice being that Cusucurida et al. still teaches the step of the producing the polyurethane. Cuscurida et al. does not disclose a low free isocyanate monomer. Peter discloses a polyurethane composition being reactable with a low free isocyanate monomer (See Column 4, lines 4 through 25). One having ordinary skill in the art would have found it obvious to incorporate a low free isocyanate monomer into

the polyurethane composition of Cuscurida et al., as taught by Peter, for economical purposes.

In regards to claim 48, Cuscurida et al. inherently discloses the second reactable component having a molecular weight of about 400 g/mol or greater being that the second reactable component is the same as that claimed by the applicant.

In regards to claim 49, Cuscurida already discloses the composition solidifying in about 7.5 second. Being that Cuscurida et al. discloses the same components as that of the applicant it is submitted that the composition is capable of solidifying in less than 5 second.

In regards to claim 50, the viscosity of the material is a property already present within the material; therefore, it is submitted that the combination of Cuscurida et al. and Peter both possess this property.

In regards to claims 51 and 52, Cuscurida et al. discusses the common method of combining the two components for forming RIM. Based on the background of the invention the type of injection process and pressure would not be critical to carryout the method so long as the two components react rapidly.

In regards to claim 53, Peter discloses a first reactable component comprising less than about 0.1% free isocyanate containing monomer groups (See Column 5, lines 42 through 44).

In regards to claim 60, Cuscurida et al. does not disclose the composition containing meta- tetramethylxylylene (TMXDI-); therefore, it is submitted that TMXDI is not present.

Response to Arguments

Applicant's arguments filed 4/03/07 have been fully considered but they are not persuasive. Light stability is not a reason for carrying out the method. Light stability of an aliphatic isocyanate is only beneficial for the apparatus not carrying out the method. Aliphatic isocyanate only prevent the polyurethane from yellowing over a period of time. Regardless of the type of isocyanate, polyurethanes are produced the same way.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 571-272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH
Alvin A. Hunter, Jr.

Sgn E
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SUPERVISORY PATENT EXAMINER